



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/625,362	07/23/2003	Jiafu Fang	42053-00106USPT	8220
24238	7590	03/14/2006	EXAMINER	
JENKENS & GILCHRIST 1401 MCKINNEY SUITE 2600 HOUSTON, TX 77010			FEELY, MICHAEL J	
			ART UNIT	PAPER NUMBER
			1712	

DATE MAILED: 03/14/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/625,362

Applicant(s)

FANG ET AL.

Examiner

Michael J. Feely

Art Unit

1712

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 December 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 33-82 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 33-82 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 23 July 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Pending Claims

Claims 33-82 are pending.

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 33-69, 70, 71-75, and {77-82}, drawn to a surface treatment composition, a method of applying said surface treatment to an article, and an article treated with said surface treatment composition, classified in class 428, subclass 447.
 - II. Claims 76 and {77-82}, drawn to a surface treatment composition and a method of applying said surface treatment to an article, classified in class 427, subclass 387.

*It should be noted that claims {77-82} are linking claims.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions (I) and (II) are directed to related processes and compositions. The related inventions are distinct if the inventions as claimed do not overlap in scope, i.e., are mutually exclusive; the inventions as claimed are not obvious variants; and the inventions as claimed are either not capable of use together or can have a materially different design, mode of operation, function, or effect. See MPEP § 806.05(j).

In the instant case: the surface treatment compositions set forth in groups (I) and (II) do not overlap in scope; the surface treatment compositions set forth in groups (I) and (II) are not obvious variants; and the surface treatment compositions set forth in groups (I) and (II) are not

Art Unit: 1712

capable of use together and have a materially different design. Group (I) features a reaction product obtained by reacting an amino-functional polydimethylsiloxane and 1,2-epoxytetradecane (*in the presence of a base*), and group (II) features a methoxy-functionalized polysiloxane having a viscosity of about 20 cps at 25°C.

3. Because these inventions are independent or distinct for the reasons given above and have acquired a separate status in the art in view of their different classification, restriction for examination purposes as indicated is proper.
4. Because these inventions are independent or distinct for the reasons given above and the inventions require a different field of search (see MPEP § 808.02), restriction for examination purposes as indicated is proper.
5. Applicant is advised that the reply to this requirement to be complete must include (i) an election of a species or invention to be examined even though the requirement be traversed (37 CFR 1.143) and (ii) identification of the claims encompassing the elected invention.

The election of an invention or species may be made with or without traverse. To reserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the restriction requirement, the election shall be treated as an election without traverse.

Should applicant traverse on the ground that the inventions or species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the inventions or species to be obvious variants or clearly admit on the record that this is the case. In

Art Unit: 1712

either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C.103(a) of the other invention.

6. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Previous Claim Rejections - 35 USC § 102

7. The rejection of claims 1-3, 5, 7-9, 12, 15, 17, 19, and 25 under 35 U.S.C. 102(b) as being anticipated by Evans et al. (US Pat. No. 3,047,535) has been rendered moot by the cancellation of claims 1-32.

8. The rejection of claims 1-9, 12-20, and 25 under 35 U.S.C. 102(b) as being anticipated by Kondo et al (US Pat. No 5,853,896) has been rendered moot by the cancellation of claims 1-32.

9. The rejection of claims 1-20 and 25 under 35 U.S.C. 102(b) as being anticipated by Azzopardi et al. (US Pat. No. 5,997,943) has been rendered moot by the cancellation of claims 1-32.

10. The rejection of claims 1, 2, 4-9, 12-14, and 25 under 35 U.S.C. 102(e) as being anticipated by Kobayashi et al. (US Pat. No. 6,706,798) has been rendered moot by the cancellation of claims 1-32.

Art Unit: 1712

11. The rejection of claims 1-4, 7-9, 12, 13, and 25-27 under 35 U.S.C. 102(e) as being anticipated by Akamatsu et al. (Pub. No. US: 2003/0077457) has been rendered moot by the cancellation of claims 1-32.

Previous Claim Rejections - 35 USC § 102/103

12. The rejection of claims 21-24 and 28-32 under 35 U.S.C. 102(b/e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious alternatively over Evans et al. (US Pat. No. 3,047,535), Kondo et al. (US Pat. No. 5,853,896), Azzopardi et al. (US Pat. No. 5,997,943), Kobayashi et al. (US Pat. No. 6,706,798), or Akamatsu et al. (Pub. No.: US 2003/0077457) has been rendered moot by the cancellation of claims 1-32.

Previous Claim Rejections - 35 USC § 103

13. The rejection of claims 4, 6, 13, 14, 16, 18, and 20 under 35 U.S.C. 103(a) as being unpatentable over Evans et al. (US Pat. No. 3,047,535) has been rendered moot by the cancellation of claims 1-32.

14. The rejection of claims 26 and 27 under 35 U.S.C. 103(a) as being unpatentable alternatively over Evans et al. (US Pat. No. 3,047,535), Kondo et al. (US Pat. No. 5,853,896), Azzopardi et al. (US Pat. No. 5,997,943) or Kobayashi et al. (US Pat. No. 6,706,798) has been rendered moot by the cancellation of claims 1-32.

Art Unit: 1712

Communication

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael J. Feely whose telephone number is 571-272-1086. The examiner can normally be reached on M-F 8:30 to 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy Gulakowski can be reached on 571-272-1302. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Michael J. Feely
Primary Examiner
Art Unit 1712

March 10, 2006

MICHAEL FEELY
PRIMARY EXAMINER